

Appl. No. 09/920,782  
Amdt. Dated 05/23/2005  
Reply to Office Action of 02/22/2005

### **REMARKS/ARGUMENTS**

This Amendment is in response to the Office Action mailed February 22, 2005. In the Office Action, claims 1-3 and 6-14 were rejected under 35 U.S.C. §102, and claims 4-5 and 15-19 were rejected under 35 U.S.C. §103. Reconsideration in light of the amendments and remarks made herein is respectfully requested.

#### ***Rejection Under 35 U.S.C. § 102***

Claims 1-3 and 6-14 were rejected under 35 U.S.C. §102(b) as being anticipated by Shiino (5,946,607). Applicant respectfully traverses the rejection because a *prima facie* case of anticipation has not been established. For clarity purposes, the grounds for traversing the dependent claims shall not be discussed in detail since Applicant believes that the independent claims as amended are in condition for allowance. Applicant reserves the right to present such arguments if an appeal is warranted.

As the Examiner is aware, to anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Vergegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989).

With respect to independent claims 1, 8, and 14, Applicant respectfully submits that Shiino does not describe each and every limitation set forth in these newly amended claims.

For instance, with respect to claim 1, Shiino does not teach *taking a plurality of samples of received signal in a feedback path* for controlling an automatic gain control component. *Emphasis added*. In fact, claims 8 and 14 also include limitations that the multiple samples are taken during the feedback path. In contrast, Shiino teaches the calculation of an average power for a corrected received signal Cr(n), which is a difference between digital received signal R(n) and direct-current offset (Rdc) from the offset detector (58). Shiino does not teach multiple sampling in the feedback path as claimed, but instead teaches multiple sampling to produce Rdc.

In addition, Shiino does not teach or computing an *average value of said calculated powers* for the plurality of samples as set forth in claims 1 and 14. In contrast, Shiino teaches an average power calculator (46) which merely calculates the average power of the corrected received signal Cr(n).

In light of the amendments set forth above, Applicant respectfully requests the Examiner to withdraw the §102(b) rejections.

#### ***Rejection Under 35 U.S.C. § 103***

Claims 4 and 5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shiino in view of Cahill (U.S. Patent No. 5,083,304). Claims 4 and 5 depend on independent claim 1.

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Thus, these claims are allowable based on their dependency on an allowable claim. Applicant respectfully reserves the right to further submit additional grounds for traversing the rejection is an appeal is warranted.

In light of the foregoing, Applicant respectfully requests the Examiner to withdraw the §103(a) rejection as applied to claims 4 and 5.

Claims 15-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shiino. Applicant respectfully submits that a *prima facie* case of obviousness has not been established.

As the Examiner is aware, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. See MPEP §2143; see also *In Re Fine*, 873 F. 2d 1071, 5 U.S.P.Q.2D 1596 (Fed. Cir. 1988). Herein, at a minimum, the combined teachings of the cited references do not describe or suggest all the claim limitations.

As an illustrative example, Shiino does not teach the *feedback gain control signal* as claimed, which is based on average power levels of multiple samples of a digital signal as measured *in a feedback path* by an automatic gain control system. *Emphasis added*. Instead, the average power computations are not directed toward multiple samples, especially not within the feedback path. Multiple samples are maintained to compute the direct-current offset (Rdc), but these values are not used by average power calculator (46), as would be required based on the Examiner's interpretation on Page 2 of the Office Action that computing of the average power is performed by average power calculator (46).

In light of the amendments set forth above, Applicant respectfully requests the Examiner to withdraw the §103(a) rejection as applied to claims 15-19.

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**Conclusion**

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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Dated: 05/23/2005

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